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| GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191 | | | JONES, HEATHER RAE | |
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| | | | 2621 | |

DATE MAILED: 07/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/987,872

Applicant(s)

ESENYAN ET AL.

Examiner

Heather R. Jones

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>2/19/02</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 6-9, 11, 13-16, 19-26, 28, and 30-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Ebadollahi et al. (U.S. Patent 6,514,207).

Regarding claim 6, Ebadollahi et al. discloses a computer readable medium storing a computer program that enables recording and time-marking of significant events during a medical procedure in video footage, indexing patient data with the video footage, and then editing and accessing the video footage with patient data and diagnostic information from a database in an efficient and expedient manner, the medium comprising: a source code segment that inserts at least one time-mark into the video footage (col. 7, lines 28-42); a source code segment that associates an index with the at least one time-mark (col. 4, lines 45-49; col. 7, lines 8-51); a source code segment that extracts at least one portion of the video footage at the at least one time-mark, wherein the at least one portion begins before the at least one time-mark and ends after the at least

one time-mark (col. 4, lines 36-49); a source code segment that concatenates the extracted at least one portion of video footage together with at least another portion of video footage into a shortened summary video clip; and a source code segment that stores, both the video footage and shortened summary video clip with associated indices, into a searchable database (col. 10, lines 54-65).

Regarding claim 7, Ebadollahi et al. discloses all the limitations as previously discussed with respect to claim 6 as well as further disclosing a source code segment that maintains and updates at least one patient's medical record with at least one of data from the index, video footage, and still pictures from the medical procedure (col. 11, lines 48-54; col. 12, lines 6-16).

Regarding claim 8, Ebadollahi et al. discloses all the limitations as previously discussed with respect to claim 6 the computer readable medium according to claim 6, including that the index comprises data fields for at least one of a name, medical finding, finding location, and free text (Figs. 10 and 11; col. 11, lines 12-24 and 48-54; col. 12, lines 6-16).

Regarding claim 9, Ebadollahi et al. discloses all the limitations as previously discussed with respect to claims 6 and 8 including that the data for the index is capable of being input real-time during a medical procedure and post-procedure during review (col. 7, lines 28-51; col. 12, lines 6-54).

Regarding claim 11, Ebadollahi et al. discloses all the limitations as previously discussed with respect to claim 6 including that the time-mark is

capable of being input in real-time during a medical procedure and post-procedure during review (col. 12, lines 35-54).

Regarding claim **13**, Ebadollahi et al. discloses all the limitations as previously discussed with respect to claim 6 as well as further disclosing a source code segment that provides a specialty video player (col. 5, lines 3-5; col.12, lines 6-16)

Regarding claim **14**, Ebadollahi et al. discloses all the limitations as previously discussed with respect to claims 6 and 13 including that the specialty video player includes a playback speed control which provides for playback speeds ranging from a reduced speed to an accelerated speed as compared to a normal speed (col. 5, lines 3-5; col. 12, lines 6-16 – it is inherent that the player would be able to control the playback speed in order for the physician to get a better look at the patients condition so they can make a proper analysis).

Regarding claim **15**, Ebadollahi et al. discloses all the limitations as previously discussed with respect to claims 6 and 13 as well as further disclosing a source code segment that enables jumping backward to a previous time- mark or jumping forward to a next time-mark (col. 10, liens 54-65; col. 12, lines 6-16).

Regarding claim **16**, Ebadollahi et al. discloses all the limitations as previously discussed with respect to claims 6 and 13 as well as further disclosing a source code segment that provides a capture still image feature which stores a still picture within at least one patient's medical record (col. 4, lines 43-45).

Regarding claim **19**, a computer-based video recording and management system, used in conjunction with medical diagnostic equipment, which allows recording and time-marking of significant events during a medical procedure on video footage, indexing patient data with the video footage, and then editing or accessing the video footage with patient data from a database in an efficient manner, the system comprising: at least one input device that inserts at least one time-mark into the video footage (col. 7, lines 28-42); and at least one workstation that associates an index with each time-mark, extracts at least a portion of the video footage at the at least one time-mark beginning before and ending after the at least one time-mark, concatenates the at least one portion of the video footage with at least another portion of video footage into a shortened summary video clip, and stores both the video footage and summary video clip into a searchable database ((col. 4, lines 45-49; col. 7, lines 8-51; col. 4, lines 36-49; col. 10, lines 54-65).

Regarding claim **20**, Ebadollahi et al. discloses all the limitations as previously discussed with respect to claim 19 including that the at least one input device comprises a medical instrument having a video source, the video source being connected to the at least one workstation (Fig. 1).

Regarding claim **21**, Ebadollahi et al. discloses all the limitations as previously discussed with respect to claim 19 including that the at least one workstation maintains at least one patient's medical record (Figs. 10 and 11).

Regarding claim **22**, Ebadollahi et al. discloses all the limitations as previously discussed with respect to claim 19 the system according to claim 19, wherein the index comprises data fields for at least one of a name, medical finding, finding location, and free text (Figs. 10 and 11; col. 11, lines 12-24 and 48-54; col. 12, lines 6-16).

Regarding claim **23**, Ebadollahi et al. discloses all the limitations as previously discussed with respect to claims 19 and 22 including that the data for the index is capable of being input real-time during a medical procedure and post-procedure during a review period (col. 7, lines 28-51).

Regarding claim **24**, Ebadollahi et al. discloses all the limitations as previously discussed with respect to claim 19 including that the at least one workstation is connected to a network (col. 12, lines 6-8 – another physician can look at the patient's data from a remote location).

Regarding claim **25**, Ebadollahi et al. discloses all the limitations as previously discussed with respect to claims 19 and 24 including that the at least one workstation is connected to the network via an Internet connection (col. 12, lines 17-22).

Regarding claim **26**, Ebadollahi et al. discloses all the limitations as previously discussed with respect to claims 19 and 24 as well as further disclosing at least one file server having a video storage array connected to the network which stores at least one patient's medical record (Fig. 1).

Regarding claim **28**, Ebadollahi et al. discloses all the limitations as previously discussed with respect to claims 19 and 20 including that the medical instrument comprises one of an ultrasound device, fluoroscopy device, x-ray device and surgical camera (col. 3, lines 34-39).

Regarding claim **30**, Ebadollahi et al. discloses all the limitations as previously discussed with respect to claim 19 including that the input device is activated, the system encapsulates data with the video footage for indexing purposes (col. 10, lines 49-65).

Regarding claim **31**, Ebadollahi et al. discloses all the limitations as previously discussed with respect to claims 19 and 24 including the network comprises a peer-to-peer network (col. 12, lines 6-54).

Regarding claim **32**, Ebadollahi et al. discloses all the limitations as previously discussed with respect to claims 19, 24, and 26 including that the database is located in one of the at least one workstation and the at least one file server (Fig. 1).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ebadollahi et al. (U.S. Patent 6,514,207) in view Tien (U.S. Patent 6,938,029).

Regarding claim 1, Ebadollahi et al. discloses a computer readable medium storing a computer program that provides a computer-based video recording and management system for medical procedures, the medium comprising: a source code segment that inserts at least one time-mark into video footage upon receiving input from a user, the at least one time-mark capable of being inserted into the video footage real-time while the video footage is being recorded and post procedure during review (col. 7, lines 28-42); and a source code segment that associates an index with the at least one time-mark, data capable of being input into the index real-time during a medical procedure and post-procedure during review (col. 4, lines 45-49; col. 7, lines 8-51). However, Ebadollahi et al. fails to disclose that the user inserts the time-marks.

Referring to the Tien reference, Tien discloses a system wherein the user inserts the time-marks (col. 2, line 59 – col. 3, line 4).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have allowed the user to insert the time-mark as disclosed by Tien in the management system as disclosed by Ebadollahi et al. in order to allow the user to mark points in the video that they find interesting rather than allowing the equipment to make all the time-marks because the equipment may miss points that are interesting to the user.

Regarding claim 2, Ebadollahi et al. in view of Tien discloses all the limitations as previously discussed with respect to claim 1 including that the index comprises data for at least one of a patient's name, medical finding, finding location, and free text (Ebadollahi et al.: Figs. 10 and 11; col. 11, lines 12-24 and 48-54; col.12, lines 6-16).

Regarding claim 3, Ebadollahi et al. in view of Tien discloses all the limitations as previously discussed with respect to claims 1 and 2 including that the data is transmitted from at least one of a medical instrument, microphone, footpedal/switch, mouse and computer keyboard operated by a user of the system (Ebadollahi et al.: Fig. 1; col. 3, lines 34-39).

Regarding claim 4, Ebadollahi et al. in view of Tien discloses all the limitations as previously discussed with respect to claim 1 as well as further disclosing a source code segment that extracts at least one portion of the video footage starting at a predetermined period of time before the at least one time-mark and ending at a predetermined period of time after the at least one time-mark (Ebadollahi et al.: col. 4, lines 45-49).

Regarding claim 5, Ebadollahi et al. in view of Tien discloses all the limitations as previously discussed with respect to claims 1 and 4 including that the at least one portion of video footage is concatenated with at least another portion of video footage into a shortened summary video clip (Ebadollahi et al.: col. 10, lines 54-65).

5. Claims 10, 12, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ebadollahi et al. as applied to claim 6 above, and further in view of Tien (U.S. Patent 6,938,029).

Regarding claim **10**, Ebadollahi et al. discloses all the limitations as previously discussed with respect to claim 6, but fails to disclose that the time-mark is inserted according to a user input device.

Referring to the Tien reference, Tien discloses a system wherein the user inserts the time-marks (col. 2, line 59 – col. 3, line 4).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have allowed the user to insert the time-mark as disclosed by Tien in the management system as disclosed by Ebadollahi et al. in order to allow the user to mark points in the video that they find interesting rather than allowing the equipment to make all the time-marks because the equipment may miss points that are interesting to the user.

Regarding claim **12**, Ebadollahi et al. discloses all the limitations as previously discussed with respect to claim 6 and Ebadollahi et al. in view of Tien discloses all the limitations as previously discussed with respect to claim 10, but they fail to disclose a source code segment that notifies whether the insertion of the at least one time-mark was successful or failed, by displaying a message on a monitor. Official Notice is taken that it is well known in the art to alert a user that the function they are trying to perform on an electronic device is successful or not. Therefore, it would have been obvious to one of ordinary skill in the art at

the time the invention was made to have alerted the user as to whether or not the insertion of the at least one time-mark was successful or failed, by displaying a message on a monitor in order to inform the physician if the images they wanted were the images that were going to be included in the summary so that the physician does not miss a key point their analysis.

Regarding claim **17**, Ebadollahi et al. discloses all the limitations as previously discussed with respect to claims 6 and 13, but fails to disclose a source code segment that provides a create marker and delete marker feature which allows for the creation and deletion of the at least one time-marker within the video footage.

Referring to the Tien reference, Tien discloses a system wherein a source code segment that provides a create marker and delete marker feature which allows for the creation and deletion of the at least one time-marker within the video footage.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have allowed the user to create markers and delete markers in order for the physician to mark things that they didn't see before or to delete things that they don't find relevant anymore.

Regarding claim **18**, Ebadollahi et al. discloses all the limitations as previously discussed with respect to claim 6, but fails to disclose a source code segment which provides a voice activated data entry system allowing data to be entered via voice.

Referring to the Tien reference, Tien discloses a system wherein a source code segment that provides a voice activated data entry system allowing data to be entered via voice (col. 8, lines 23-27).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a system source code segment that provides a voice activated data entry system allowing data to be entered via voice so that the physician could give voice activate commands when their hands are full and they are too busy performing the medical procedure.

6. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ebadollahi et al. as applied to claim 19 above.

Regarding claim **27**, Ebadollahi et al. discloses all the limitations as previously discussed with respect to claim 19, but fails to disclose that the medical instrument comprises an endoscope. However, Ebadollahi et al. discloses a medical instrument that provides a video footage. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have substituted an endoscope for the medical instrument disclosed by Ebadollahi et al. because the system is set up to handle video footage being input from a medical instrument.

7. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ebadollahi et al. as applied to claim 19 above, and further in view of Tien (U.S. Patent 6,938,029).

Regarding claim **29**, Ebadollahi et al. discloses all the limitations as previously discussed with respect to claim 19, but fails to disclose that the input device comprises a foot pedal/switch, microphone, mouse, and computer keyboard.

Referring to the Tien reference, Tien discloses a system wherein a source code segment that provides a voice activated data entry system allowing data to be entered via voice (col.8, lines 23-27 - a microphone would be needed for voice activated commands).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a system source code segment that provides a voice activated data entry system allowing data to be entered via voice so that the physician could give voice activate commands when their hands are full and they are too busy performing the medical procedure.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Heather R. Jones whose telephone number is 571-272-7368. The examiner can normally be reached on Mon. - Thurs.: 7:00 am - 4:30 pm, and every other Fri.: 7:00 am - 3:30 pm.

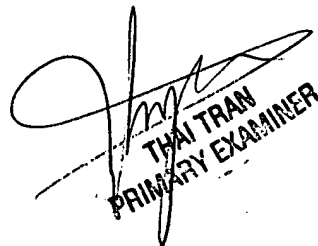
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Heather R Jones
Examiner
Art Unit 2621

HRJ
June 26, 2006



THAI TRAN
PRIMARY EXAMINER